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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055161
Party	Defendant SiingaporeMath.com Inc.
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Submission	Answer
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Date	03/26/2012
Attachments	20120326 Answer to Petition for Cancellation SGA401CAN.pdf ( 10 pages ) (113802 bytes )

Houghton Mifflin Harcourt  
Publishing Company

 $V_{\text{c}}$ 

Registrant.

Cancellation No. 92055161

Sir:

Registrant, SingaporeMath.com Inc. (hereinafter referred to as “SingaporeMath”), through its attorneys, for its answer to the Petition for Cancellation filed by petitioner, Houghton Mifflin Harcourt Publishing Company (hereinafter referred to as “HMH”) answers as follows:

1. Petitioner is a leading global education and learning company and the world's largest provider of educational materials for pre-K - 12 learning.

Registrant lacks information upon which to base an acceptance or denial.

2. Petitioner is the distributor in the United States of a series of mathematics textbooks and workbooks for kindergarten through sixth grade entitled *Math in Focus: Singapore Math* (the “HMH” Books) which is published by Marshall Cavendish Education Singapore.

Registrant lacks information upon which to base an acceptance or denial.

3. The HMH Books follow the pedagogical framework of teaching mathematics that

was developed by the Singapore Ministry of Education, and is known outside of Singapore as “Singapore Math”.

**ANSWER**

Registrant lacks information upon which to base an acceptance or denial as to the HMH books; denied as to use of the phrase “Singapore Math.”

4. Petitioner also offers for sale, sells and distributes related educational materials in connection with its HMH Books.

**ANSWER**

Registrant lacks information upon which to base an acceptance or denial.

5. Petitioner has been distributing the HMH Books in the United States since at least as early as April 2009.

**ANSWER**

Registrant lacks information upon which to base an acceptance or denial.

6. Upon information and belief, Registrant is a corporation organized under the laws of the state of Oregon with a principal place of business at 404 Beaver Creek Road, #225, Oregon City, Oregon 97405.

**ANSWER**

Admitted.

7. Upon information and belief, Registrant is the distributor in the United States of a series of mathematics textbooks and workbooks for first through fifth grades entitled *Primary Mathematics* which are published by Marshall Cavendish Education Singapore.

**ANSWER**

Denied.

8. Upon information and belief, Registrant’s *Primary Mathematics* books also follow the “Singapore Math” curriculum.

**ANSWER**

Denied as to Petitioner's self-serving use of the phrase "Singapore Math" curriculum," a phrase which Registrant believes has and is not used in the pertinent market. Registrant admits that the books that it distributes follow the Singapore approach to teaching mathematics.

**First Basis for Cancellation - Genericness**

9. Upon information and belief, in or around 1980 the Singapore Ministry of Education developed a new mathematics curriculum for use in Singapore schools whereby students master core concepts and then move onto solving problems by applying that knowledge.

**ANSWER**

Registrant lacks information upon which to base an acceptance or denial.

10. In the United States and countries other than Singapore the term "Singapore Math" refers to this mathematics teaching curriculum developed by the Singapore Ministry of Education.

**ANSWER**

Denied.

11. The term "Singapore Math" is commonly and widely used by educational publishers, school systems, teachers, parents and students to identify the approach to and method of teaching mathematics known as "Singapore Math". Attached as Exhibit 1 are examples of third parties' uses of the term "Singapore Math".

**ANSWER**

Denied.

12. The term "Singapore Math" is generic in that the primary significance of the term to the relevant public is as the name of the mathematics teaching method that originated in Singapore.

**ANSWER**

Denied.

13. Registrations for SINGAPORE MATH composite marks that issued earlier than the Registered Marks disclaim the term SINGAPORE MATH. Attached as Exhibit 2 are copies of Certificates of Registration for SINGAPORE MATH composite marks.

**ANSWER**

Admitted.

14. The Office Action and Final Office Action issued in the prosecution of the mark SINGAPORE MATH both asserted that the mark “appears to be generic in connection with the identified goods and, therefore, [is] incapable of functioning as a source-identifier for applicant’s goods.”

**ANSWER**

Admitted.

15. In response to the Office Actions issued in the prosecution of Registered Marks, Registrant claimed that the Registered Marks had acquired distinctiveness under 2(f) of the Trademark Act.

**ANSWER**

Admitted.

16. The first 2(f) claim that Registrant submitted for the mark SINGAPORE MATH was accepted by the U.S. Patent & Trademark Office and the application was approved for publication.

**ANSWER**

Admitted.

17. However, in the prosecution of the mark SINGAPOREMATH.COM, the U.S. Patent & Trademark Office rejected Registrant’s initial 2(f) claim because “the mark is possibly generic that more evidence is needed”.

**ANSWER**

Admitted.

18. After Registrant submitted additional evidence in support of its 2(f) claim for the mark SINGAPOREMATH.COM, the application was approved for publication.

**ANSWER**

Admitted.

19. Petitioner submits that the U.S. Patent & Trademark Office erred in accepting Registrant's 2(f) claims of acquired distinctiveness for the Registered Marks and approving the applications for publication because the marks were and are incapable of serving as a source-identifier for Registrant's goods.

**ANSWER**

Denied.

20. As the Registered Marks are generic, they are, by definition, incapable of indicating a particular source of the goods. Thus, the Registered Marks cannot be registered as trademarks.

**ANSWER**

Denied.

21. The registration of the Registered Marks has granted Registrant a monopoly over the use of the term "Singapore Math", since a competitor such as Petitioner cannot describe its goods as what they are.

**ANSWER**

Denied.

22. Petitioner has a valid right to use the term "Singapore Math" in connection with its educational materials relating to the method of teaching mathematics that is based on the Singapore math curriculum known as "Singapore Math".

**ANSWER**

Denied.

### **Second Basis for Cancellation - Fraud**

23. Upon information and belief, Registrant was aware of Petitioner and other third parties' uses of the term "Singapore Math" in connection with math education materials prior to filings its trademark applications for the Registered Marks.

#### **ANSWER**

Denied as to use of that phrase as a trademark by Petitioner; Registrant lacks information upon which to base an acceptance or denial as to "other third parties' uses."

24. Upon information and belief, Registrant was aware that Petitioner's and other third parties' uses of the term "Singapore Math" in connection with math education materials were substantial.

#### **ANSWER**

Denied as to use of that phrase as a trademark by Petitioner; Registrant lacks information upon which to base an acceptance or denial as to "other third parties' uses."

25. Upon information and belief, Registrant was aware that Petitioner's and other third parties' uses of the term "Singapore Math" in connection with math education materials were non-infringing.

#### **ANSWER**

Denied as to use of that phrase as a trademark by Petitioner; Registrant lacks information upon which to base an acceptance or denial as to "other third parties' uses."

26. In support of its applications for the Registered Marks, Registrant filed with the U.S. Patent & Trademark Office Declarations of Distinctiveness under 2(f) of the Trademark Act which included Registrant's declarations under oath, through its President, Jeffery Thomas, that Registrant has "substantially exclusively" used the mark SINGAPORE MATH and SINGAPOREMATH.COM.

**ANSWER**

Admitted.

27. Upon information and belief, these statements were false when they were made in that Registrant was unaware of Petitioner's and other third parties' consequential non-infringing uses of the term "Singapore Math" in connection with educational materials.

**ANSWER**

Denied as to use of that phrase as a trademark by Petitioner; Registrant lacks information upon which to base an acceptance or denial as to "other third parties' uses."

28. Registrant has not enjoyed substantial and exclusive use of the term "Singapore Math" due to Petitioner's and other third parties' substantial non-infringing uses of the term in connection with educational materials.

**ANSWER**

Denied as to use of that phrase as a trademark by Petitioner; Registrant lacks information upon which to base an acceptance or denial as to "other third parties' uses."

29. Upon information and belief, Registrant knew that the statement was false at the time it was made and filed with the U.S. Patent & Trademark Office.

**ANSWER**

Registrant lacks information upon which to base an acceptance or denial as to "the statement."

30. Upon information and belief, Registration intentionally made this false statement with the intent to fraudulently induce the U.S. Patent & Trademark Office to act in reliance thereon by approving its applications for the Registered Marks for registration.

**ANSWER**

Registrant lacks information upon which to base an acceptance or denial as to "this false



statement.”

31. Registrant's acts constitute fraud on the U.S. Patent & Trademark Office and have wrongfully induced the U.S. Patent & Trademark Office to approve the Registered Marks, which action the U.S. Patent & Trademark Office would not have taken but for the fraudulent statements.

**ANSWER**

Denied.

32. The registrations for the Registered Marks should therefore be cancelled.

**ANSWER**

Denied.

**AFFIRMATIVE DEFENSES**

**FIRST AFFIRMATIVE DEFENSE**

The Petition fails to state a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE**

The Petition is barred in whole or in part by the doctrine of laches.

**THIRD AFFIRMATIVE DEFENSE**

The Petition is barred in whole or in part by the doctrines of waiver, acquiescence, and estoppel.

**FOURTH AFFIRMATIVE DEFENSE**

The Petition is barred in whole or in part because Petitioner has committed fraud.

**FIFTH AFFIRMATIVE DEFENSE**

The Petition is barred in whole or in part by because Petitioner has unclean hands.

**SIXTH AFFIRMATIVE DEFENSE**

The Petition is barred in whole or in part by because Petitioner is mistaken as to the pertinent facts supporting the Petition.

WHEREFORE, registrant requests that the Petition for Cancellation be dismissed with prejudice.

Respectfully submitted,

Dated: March 26, 2012

/ David P. Cooper /  
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CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being filed electronically with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals this 26<sup>th</sup> day of March, 2012.

/ Margaret R. Burton /  
Margaret R. Burton

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of ANSWER TO PETITION FOR CANCELLATION was served on petitioner by service on its attorneys Mary A. Donovan and Sarah B. Kickham of Donovan & Yee LLP, located at 161 Avenue of the Americas, Suite 1201, New York, NY 10013, via first class mail, postage prepaid, in a sealed envelope to the aforementioned address on March 26, 2012, courtesy copy via email.

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/ David P. Cooper /  
David P. Cooper  
of Attorneys for Registrant